

**REMARKS**

Claims 1-34 are pending and remain in the application. No new matter has been introduced.

Claims 1-5, 8-13, 16, 17, 33, and 34 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,692,206, issued to Shirley et al. ("Shirley"), in view of U.S. Patent No. 5,774,866, issued to Horowitz et al. ("Horowitz"). Applicant traverses the rejection.

To establish a *prima facie* case of obviousness, the examiner has the burden of proving that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there is a reasonable expectation of success; and (3) the combined references teach or suggest all the claim limitations. MPEP § 2143. A *prima facie* of obviousness case has not been shown.

The Shirley patent discloses a contract generation system, which provides standard contracts that can be customized with alternative, supplemental, and additional provisions (Col. 2, lines 11-14). The standard contract documents comprise at least one standard contract having a plurality of standard provisions (Col. 2, lines 42-44). Existing contract folders, standard contract documents, and provision libraries are preferably contained on mass storage devices of a personal computer (Col. 6, lines 26-29). The provision libraries comprise a shared provision library and a number of contract-type provision libraries (Col. 5, lines 14-16). The shared provision library comprises a set of standard provisions and a set of user defined provisions; the standard provisions comprise one or more alternate provisions, one or more supplemental provisions, and one or more additional provisions (Col. 5, lines 22-30).

The Horowitz patent discloses methods of operating a computer system to check relationship problems in an organization including a plurality of persons (Col. 3, lines 19-21). Intelligible existing relationship data denotes one or more existing parties having existing relationships within the organization, and also

denotes an association between each such existing party and one or more persons within the organization (Col. 3, lines 24-28). For example, in a law firm, the association data may denote one or more attorneys as responsible for the matters being handled on behalf of each existing client (Col. 3, lines 28-31). Intelligible  
5 proposed relationship data denotes one or more proposed parties associated with each proposed matter (Col. 3, lines 32-34). The proposed relationship data and the existing relationship data are compared and a potential matter is identified as having a match when a proposed party associated with the proposed matter matches an existing party (Col. 3, lines 35-40). The existing and proposed parties  
10 are treated as matching one another if data designating the proposed party and data designating the existing party correspond to one another to at least a preselected degree of correspondence (Col. 3, lines 43-47). Once a match is found, the system retrieves the party relationship and type data for both parties involved in the match and compares the data to determine whether a potential  
15 conflict exists (Col. 18, lines 62-67). A problem signaling routine is performed for at least some of the identified matches within the computer system and automatically sending a potential problem signal incorporating information about the match to an evaluator (Col. 3, lines 50-52 and 59-62). For example, in a law firm, the attorneys responsible for the affairs of an existing client can be informed  
20 of potential conflicts relating to that existing client (Col. 4, lines 10-12). The system further receives problem clearance signals sent by the evaluators and automatically clears potential problem status responsive to the problem clearing signals (Col. 3, lines 62-65).

First, there is no suggestion or motivation to modify or combine the  
25 references. Shirley discloses a contract generation system that automates the generation of various legal documents related to a negotiated agreement (Abstract). Shirley teaches a contract authoring system responsive to requests from a user to manage the creation of a contract document (Col. 2, lines 24-28). Horwitz discloses a system for checks for conflicts, termed "relationship  
30 problems," associated with proposed new matters in an organization, which deals

with numerous clients (Abstract; Col. 2, line 61-Col. 3, line 10). Horwitz teaches tracking data relating to both existing matters and potential matters in a central matter table, in which a given record in a matter table may lead to one or more records in an assigned persons table (Col. 10, lines 37-40 and 47-49). In turn, the assigned persons table is keyed to a table of assigned person roles, which include "billing," "responsible," and "other" (Col. 10, lines 52-62). The data structure taught by Horwitz makes possible retrieving data relating to the role of persons assigned to a particular matter (Col. 10, lines 62-Col. 11, line 14). The role of a person generating a contract, as taught by Shirley, presupposes that no conflict of interest or other relationship problem exists, as taught by Horwitz. Conversely, complex relationships between existing or proposed clients and others, as taught by Horwitz, can co-exist with contract generation, as taught by Shirley. Thus, there is no suggestion or motivation to modify or combine these references.

Second, one of ordinary skill in the art would have no reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). The Shirley reference teaches automating the generation of a legal document in combination with a contract authoring unit, an informational legal advisor, a revision maintenance unit, and a redline unit with the objects of providing more flexibility in defining the terms of a particular contract, to allow for the negotiation of contract terms with another party and to provide the operator with sufficient flexibility to be useful in a greater variety of situations (Col. 1, line 66-Col. 2, line 61). The Horwitz reference teaches methods of operating computer systems to check and clear relationship problems, including conflicts, and potential business conflicts can be treated in exactly the same manner as potential legal conflicts, that is, where prospects are associated with particular responsible persons, a potential conflict signal can be sent to each such person upon

occurrence of a potential conflict involving a prospect in exactly the same manner as a potential conflict involving a party and the system can be arranged to deny conflict clearance until the responsible person for each such prospect has assented (Col. 3, lines 13-17; Col. 25, lines 44-52). Combining the teachings of Shirley  
5 with the teachings of Horwitz would add relationship problem checking and clearance into an automated contract authoring system, but would nevertheless fail to provide flexibility useful in a greater variety of situations than would otherwise be provided by Shirley. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

10 Finally, the combined references fail to teach or suggest all the claim limitations. The combination of the teachings of Shirley and Horwitz defines comparing proposed relationship data and existing relationship data and identifying a potential matter as having a match when a proposed party associated with a proposed matter matches an existing party. In contrast, Independent Claim  
15 1 defines “a list of authorizations stored into the database with each authorization controlling clause modification and usage by users for each individual clause; a list of preferences stored into the database with each preference influencing clause selection for each individual party; and a clause selection module authenticating each selection of an individual clause from the individual clauses table against the  
20 authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” Similarly, Independent Claim 9 defines “storing a list of authorizations into the database with each authorization controlling clause modification and usage by users for each individual clause; storing a list of preferences into the database with each preference influencing clause selection for  
25 each individual party; and authenticating each selection of an individual clause from the individual clauses table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” Similarly, Independent Claim 33 defines “a list of authorizations with each authorization controlling contract clause and contract outline modification and  
30 usage by users; a list of preferences with each preference influencing contract

clause and contract outline selection for each potentially affected party; and a contract drafting module authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” Finally, Independent Claim 34 defines “storing a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users; storing a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party; and authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” The Shirley-Horwitz combination fails to teach or suggest such limitations and instead teaches and suggests associating persons to individual matters or cases by *role*, rather than controlling the modification and usage of clauses for a given user and influencing clause selection and influencing clause selection for the given user and the potentially affected parties, per Independent Claims 1, 9, 33, and 34. Thus, the combined references fail to teach or suggest all the claim limitations.

Accordingly, a *prima facie* case of obviousness has not been shown for Independent Claims 1, 9, 33, and 34. Claims 2-5 and 8 are dependent upon Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 10-13, 16, and 17 are dependent upon Claim 9 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. 103(a) is respectfully requested.

Claims 6, 7, 14, and 15 stand rejected under 35 U.S.C. 103(a) as being obvious over Shirley and Horowitz, in view of U.S. Patent No. 5,553,216, issued to Yoshioka et al. (“Yoshioka”). Applicant traverses the rejection.

Claims 6 and 7 are dependent upon Claim 1 and are patentable for the

above-stated reasons with respect to the first obviousness rejection, and as further distinguished by the limitations therein. Claims 14 and 15 are dependent upon Claim 9 and are patentable for the above-stated reasons with respect to the first obviousness rejection, and as further distinguished by the limitations therein.

5 Withdrawal of rejection under 35 U.S.C. 103(a) is respectfully requested.

Claims 18, 19, 21, 22, 24-26, 28, 29, 31 and 32 stand rejected under 35 U.S.C. 103(a) as being obvious over Shirley, in view of Horowitz, and further in view of U.S. Patent No. 6,202,066, issued to Barkley et al. ("Barkley").

Applicant traverses the rejection.

10 Barkley discloses a role/group permission association using object access type that associate roles with permissions and roles with a set of objects, such as resources or files (Abstract; Col. 4, lines 53-66). The same users can be given the same permissions provided with respect to an additional object by adding that role, assigned to those users, to the corresponding object (Col. 4, line 66-Col. 5,  
15 line 4).

The combined references fail to teach or suggest all the claim limitations. The combination of the teachings of Shirley, Horwitz, and Barkley defines comparing proposed relationship data and existing relationship data and identifying a potential matter as having a match when a proposed party associated  
20 with a proposed matter matches an existing party. In contrast, Independent Claim 1 defines "a list of authorizations stored into the database with each authorization controlling clause modification and usage by users for each individual clause; a list of preferences stored into the database with each preference influencing clause selection for each individual party; and a clause selection module authenticating  
25 each selection of an individual clause from the individual clauses table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties." Similarly, Independent Claim 9 defines "storing a list of authorizations into the database with each authorization controlling clause modification and usage by users for each individual clause; storing a list of  
30 preferences into the database with each preference influencing clause selection for

each individual party; and authenticating each selection of an individual clause from the individual clauses table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” Similarly, Independent Claim 33 defines “a list of authorizations with each  
5 authorization controlling contract clause and contract outline modification and usage by users; a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party; and a contract drafting module authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract  
10 outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” Finally, Independent Claim 34 defines “storing a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users; storing a list of preferences with each preference influencing contract clause and  
15 contract outline selection for each potentially affected party; and authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.” The Shirley-Horwitz-Barkley combination fails to teach or  
20 suggest such limitations and instead teaches and suggests associating persons to individual matters or cases by *role*, rather than controlling the modification and usage of clauses for a given user and influencing clause selection and influencing clause selection for the given user and the potentially affected parties, per Independent Claims 18 and 25. Thus, the combined references fail to teach or  
25 suggest all the claim limitations.

Accordingly, a *prima facie* case of obviousness has not been shown for independent Claims 18, and 25. Claims 19, 21, 22, and 24 are dependent upon Claim 18 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 26, 28, 29, 31, and 32 are  
30 dependent upon Claim 25 and are patentable for the above-stated reasons, and as

further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. 103(a) is respectfully requested.

Claims 20, 23, 27, and 30 stand rejected under 35 U.S.C. 103(a) as being obvious over Shirley, Horowitz, and Barkley, in view of Yoshioka. Applicant  
5 traverses the rejection.

Claims 20 and 23 are dependent upon Claim 18 and are patentable for the above-stated reasons with respect to the third obviousness rejection, and as further distinguished by the limitations therein. Claims 27 and 30 are dependent upon Claim 25 and are patentable for the above-stated reasons with respect to the third  
10 obviousness rejection, and as further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. 103(a) is respectfully requested.

The prior art made of record and not relied upon has been reviewed by the applicant and is considered to be no more pertinent than the prior art references already applied.

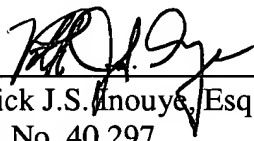
15 Examination and further consideration of the application is respectfully requested. Claims 1-34 are believed to be in a condition for allowance. Entry of the foregoing amendments is requested and a Notice of Allowance is earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

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Respectfully submitted,

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